

REMARKS

1. Status of the Claims

New claims 88 and 89 have been added to the application and are supported by original claims 1, 34 and 38.

2. Status of the Rejections

In the Advisory Action dated September 11, 2008, the Examiner advised that Applicants' previous response of August 21, 2008 overcame the rejection of 35 U.S.C § 112, second paragraph. However, the Examiner maintained the rejections of 35 U.S.C. § 112, first paragraph (written description and enablement) and under 35 U.S.C § 103(a).

3. Claim Rejections – 35 U.S.C. § 112, First Paragraph – Written Description

Claims 1, 34-38, 40-44, 46, 48, 50, 52 and 82-87 have been rejected under 35 U.S.C § 112, first paragraph, as allegedly failing to comply with the written description requirement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

Applicants' previous Response explained why the application does indeed provide adequate written description support for the claimed method, including reference to a summary of the basic process steps described in the present application (see page 16 of the Response dated August 21, 2008) and reference to the previously submitted declaration of Dr. Vitale. As a further explanation, enclosed as Exhibit 1 is a flow chart setting forth the basic steps of the presently claimed method with reference to passages in the Specification which describe those process step in a manner sufficient to convey to those skilled in the art that the Applicants indeed were in possession of the claimed invention at the time of filing. See, *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ2d 1111, (Fed. Cir. 1991).

In the Advisory Action, the Examiner maintained the written description rejection urging that Applicants' previous schematic failed to "include the final step of the screening for functional

antibodies". But the Examiner's explanation went on to note that the "data from Figures 6, 7, 9 and 10 [of the Specification] shows that examples of C-terminal modified antibodies produced by the method were in fact further examined or screened to see whether antibody secretion was improved." Applicants submit the Examiner's own comments evidence the impropriety of the continued rejection, in that, the Examiner urges that there is insufficient written description for the claimed method while at the same time the Examiner points to portions of the Specification which indeed describe results of the claimed method.

Applicants have submitted evidence to rebut the Examiner's rejection. In response, the Examiner has not submitted any counter evidence, but instead simply repeats broad general criticisms of Applicants' Specification without any evidence that one skilled in the art would not believe that the Specification conveyed to one skilled in the art the Applicants were indeed in possession of the claimed invention at the time of filing. In the absence of any such evidence, Applicants submit that the Examiner's rejection must be withdrawn.

4. Claim Rejections under 35 U.S.C. § 112, First Paragraph – Enablement

Claims 1, 34-38, 40-44, 46, 48, 50, 52 and 82-86 have been rejected for alleged lack of enablement. This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

As noted above, enclosed as Exhibit 1 is a flow chart that details the portions of the Specification that describe the steps of Applicants claimed method in a manner sufficient for one skilled in the art to make and use the claimed invention. As with the written description rejection, Applicants have submitted evidence to rebut the Examiner's rejections, but the Examiner has failed to come forth with any counter evidence. Applicants submit that the absence of any such evidence on the part of the Examiner clearly shows that the Examiner has not met the required burden for questioning the enablement for the claimed invention provided by Applicants' Specification. Accordingly, reconsideration and withdrawal of the rejection are requested.

5. Claim Rejections under 35 U.S.C. § 103(a)

Claims 1, 34, 35, 38, 40, 41, 46, 48 and 50 have been rejected under 35 U.S.C. § 103 (a) as being obvious over *Frigerio et al.* in view of *Vitale* and *Raikhel, Koide et al.* and *Matsuoka et al.* This rejection is respectfully traversed. Reconsideration and withdrawal thereof are requested.

In the previous Response, Applicants noted the Examiner's rejection failed to recognize the lack of any disclosure in any of the prior art with respect to step (b) in Applicants' claim 1. In the Advisory Action, the Examiner noted that "none [of] the individual references taken alone teach the exact language in element (b) of Claim 1, but the claims are not patentably distinguishable in view of the combined disclosures". The Examiner's Advisory Action goes on to quote various portions of the Supreme Courts' decision in *KSR*. But the Examiner notably fails to reference any portion of any of the prior art references that allegedly teach or suggest step (b) of Applicants' claim 1 either alone, or in combination. While the Examiner's Advisory Action may properly quote portions of the *KSR* decision, a proper prior art rejection must still be based upon disclosures in the prior art references and the Examiner has simply failed in any way to explain which prior art disclosures, even in combination, teach or suggest element (b) of Applicants' claim 1.

Accordingly, reconsideration and withdrawal of the rejection are requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson Reg. No. 30,330 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Application No. 10/535,433
Amendment dated December 23, 2008
Reply to Office Action of August 1, 2008

Docket No.: 1009-0118PUS1

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: December 23, 2008

Respectfully submitted,

By 

Leonard R. Svensson

Registration No.: 30,330

BIRCH, STEWART, KOLASCH & BIRCH, LLP

12770 High Bluff Drive

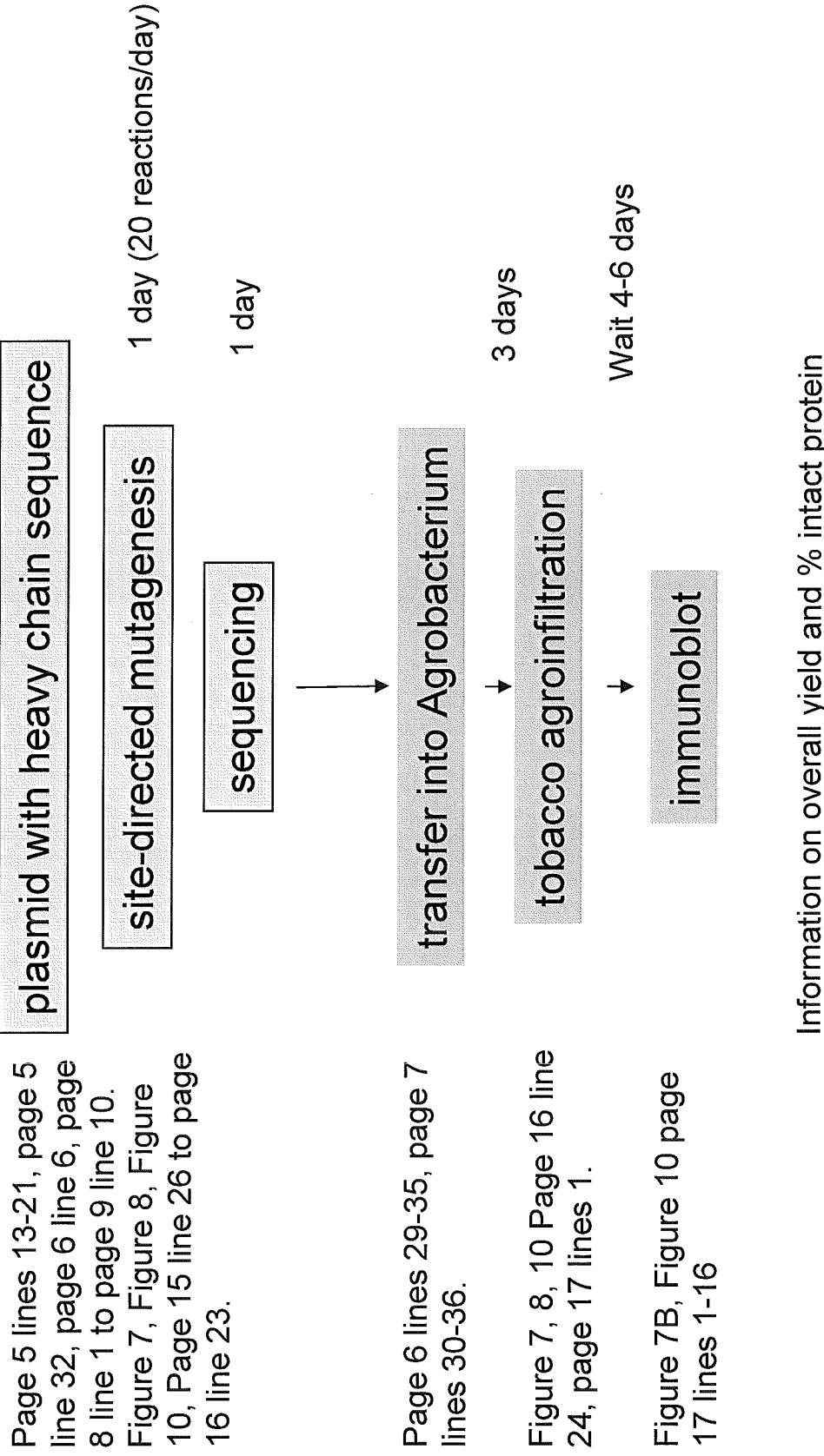
Suite 260

San Diego, California 92130

(858) 792-8855

Attorney for Applicant

EXHIBIT 1



Employing a technician and NO automation, it is possible to test up to 100 mutant/week.